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PATENT

ATTORNEY DOCKET NO. 114596-03-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.:	09/385,394	Confirmation No.:	unassigned
Applicant:	John S. Yates, Jr., et al.		
Title:	COMPUTER WITH TWO EXECUTION MODES		
Filed:	August 30, 1999	Art Unit:	2183
Atty. Docket:	114596-03-4000	Examiner:	Richard Ellis

CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that the attached

- Return postcard
- This Certificate of Mailing
- Change of Correspondence Address
- Fourth Response to Office Action
- Summary of Interview (10/30/2005) with T.C. Director Harvey
- Conditional Petition For Extension Of Time Under 37 C.F.R. § 1.136(b) And In The Alternative 1.136(a)
- Response To Office Action, Or In The Alternative, Appeal Brief (with Claims Appendix and Evidence Appendix)

(along with any paper(s) referred to as being attached or enclosed) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: November 28, 2005

By: David E. Boundy

David E. Boundy
Registration No. 36,461

WILLKIE FARR & GALLAGHER LLP
787 Seventh Ave.
New York, New York 10019
(212) 728-8000
(212) 728-8111 Fax

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SUMMARY OF INTERVIEW (10/30/2005) WITH T.C. DIRECTOR HARVEY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

An interview was conducted between T.C. Director Jack Harvey and the undersigned attorney by telephone on October 30.

1. This attorney requested clarification of the following sentence from SPrE Johnson's paper of 9/9/2005, page 5, lines 1-3: "[T]here is no requirement for element for element or limitation for limitation identification between the claims and reference(s) be provided to applicant in the grounds of rejection set forth in the examination process." In the interview, this attorney specifically drew T.C. Director Harvey's attention to 37 C.F.R. § 1.104(c)(2), § 1.113(b) and MPEP § 2142-2143.03. T.C. Director Harvey offered no elaboration of his view.

2. Applicant offers the following observations. 37 C.F.R. § 1.104(a) requires that examination "shall be complete." 37 C.F.R. § 1.104(c)(2) requires that "the particular part [of each reference] relied on must be designated as nearly as practicable" and, at least for all obviousness rejections, that "the pertinence of each reference, if not apparent, must be clearly explained." 37 C.F.R. § 1.113(b) requires that all grounds be stated "clearly" before rejection is made final. MPEP § 2142-2143.03 state, for example, that "...it is the duty of the examiner to explain why the combination of the teachings is proper." *In re Berg*, 320 F.3d 1310, 1315, 65 USPQ2d 2003, 2007 (Fed. Cir. 2003) requires "examiners ... are responsible for making findings, informed by their scientific knowledge, as to the meaning of prior art references...". *In re Epstein*, 32 F.3d 1559, 1570-71, 31 USPQ2d 1817, 1825 (Fed. Cir. 1995) (Plager, J., concurring) notes that "One

I certify that this correspondence, along with any documents referred to therein, is being deposited with the United States Postal Service on November 28, 2005 as First Class Mail in an envelope with sufficient postage addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dan E. Boal

> function of the PTO's *prima facie* case practice is to force the PTO examiners to set forth specific [rejections], which can be met by the applicant, and not just to make a general rejection."
>
> These rules merely state concrete examples of general principles arising under the Administrative Procedure Act, expressed in Supreme Court and Federal Circuit precedent. *Motor Vehicle Manufacturers' Assn. of the United States Inc. v. State Farm Mutual Automobile Insurance Co.*, 463 U.S. 29, 43, 48 (1983) (every written decision of every federal agency must "cogently explain why [the agency] has exercised its discretion in a given manner" and "must examine the relevant data and articulate a satisfactory explanation for its action including a rational connection between the facts found and the choice made.").

3. This attorney requested clarification of the following sentence (Paper of 9/9/2005, page 5, lines 1-3): "Contrary to the citations of case law presented by Petitioner, it cannot be seen how [an examiner's] ... 'new line of reasoning' (*In re Kronig*) or 'relying on a new portion of a reference' (*In re Wiechert*)" can be a "new ground of rejection" in the circumstances of this application. T.C. Director Harvey confirmed that that the definition of "new ground" that he applied turned solely on statutory section and choice of references. This attorney asked T.C. Director Harvey if he was aware of any written authority that supported this definition of "new ground of rejection," or that created any exception to the principles of *Kronig* or *Wiechert* quoted in the paper of 9/9/2005. T.C. Director Harvey stated that he did not.

4. T.C. Director Harvey explained as follows (this is a direct transcript of a recording made with the knowledge of T.C. Director Harvey). Note that T.C. Director Harvey states that he will rely solely on the MPEP, even though the MPEP lacks force of law to overrule court or agency precedent. T.C. Director Harvey states that "the Board cases and CCPA cases and Federal Circuit cases on defining 'new ground of rejection'" would not be "helpful" and would not be "taken further." T.C. Director Harvey stated that he would leave all legal research and determinations to other authorities in the PTO.

> DB I've cited a couple of CCPA cases that's say that the definition of new ground of rejection looks a little deeper than "same statute, same references." I have looked all over for any written statement that ["same statute, same references" is] the definition of new ground rejection. I don't think there is a written statement to that effect. So, it would just clarify things a whole -- or cut this issue right down to the bone. If you can find the statement to that effect, then if I'm wrong.
>
> JH I have to issue this petition again, and I told you I would do that, and I will sign it, and if it is something I can pull up... It's going to be whatever I

find out of the MPEP. So, it will be my search on the MPEP. I will put it in there. It's going to be a new decision.

DB I think that's fine. And would it make sense for me to send you my legal research?

JH No. We are going to keep it on point. I am not going to take this any further. You have asked me to look up what is the definition of "new ground of rejection" I will do that. We are going to remail out this [decision].

DB You are sure it wouldn't be helpful to look at the Board cases and CCPA cases and Federal Circuit cases on defining "new ground of rejection."

JH No. I am going to leave that to the petitions office when you file that petition.

5. T.C. Director's reissued paper of 11/8/2005 does not reflect that T.C. Director Harvey carried out his promise to "look up what is the definition of 'new ground of rejection.'" The reissued paper of 11/8/2005 does not reflect consideration of MPEP § 1207.03(III) (8th Ed. Rev. 3, August 2005), which expressly defers to the *Kronig* line of case law for the definition of the term "new ground." *See also* MPEP § 1208.01 (7th Ed. and 8th Ed. Jul. 1998-May 2004) (likewise deferring to *Kronig*).

6. Nonetheless, to assist T. C. Director in properly addressing all issues in his "new decision," this attorney filed a "Supplement to Petition" dated 10/31/2005, FAXed directly to SPrE Brian Johnson, and sent the attached email of 11/1/2005 to T.C. Director Harvey and to SPrE Johnson. I certify that the written copy of the email provided with this interview summary is accurate, with the addition of legal annotations, and omission of discussion of statements that T.C. Director Harvey indicated to be "off the record."

7. Applicant offers the following observations of law. Each reinforces the principle that an agency does not have authority to pick and choose which issues it will decide, to ignore grounds when multiple grounds of relief are presented, or to re-characterize the issues presented. The agency must decide the precise matter "presented to it," and each alternative ground. Applicant also comments on the T.C. Director's paper of 11/8/2005.

- 5 U.S.C. § 555(a) ("With due regard for the ... necessity of the parties ... and within a reasonable time, each agency shall proceed to conclude a matter presented to it.")
- *In re Kumar*, 418 F.3d 1361, 1367, 76 USPQ2d 1048, 1052 (Fed. Cir. 2005) ("In accordance with the Administrative Procedure Act, the agency must assure that an applicant's petition is fully and fairly treated at the administrative level...").

It is believed that this paper occasions no fee. Please charge any fee to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: November 28, 2005

By: _____

David E. Boundy
Registration No. 36,461

WILLKIE FARR & GALLAGHER LLP
787 Seventh Ave.
New York, New York 10019
(212) 728-8000
(212) 728-8111 Fax

From: David Boundy <DBoundy@Willkie.com>
To: 'jack.harvey@uspto.gov'; 'brian.l.johnson@uspto.gov'; 'brian.johnson@uspto.gov'
Sent: Tue 11/1/2005
Subject: Petition in 09/385,394

Brian P. Johnson - if this finds its way to you in error, please forward to Brian L Johnson. Thank you.

T.C. Director Jack Harvey and SPrE Brian L. Johnson
T.C. 2100

Re: Petition in 09/385,394

Dear Dir. Harvey and SPrE Johnson:

In view of the cancellation of yesterday's telephone interview [with SPrE Johnson] ... I write to mention several considerations you should include in your re-decision of the Petition pending before you.

1. If you define "new ground" differently than the 10 CCPA/Federal Circuit and 7 Board decisions cited in my papers, it would be respectful of the law to give a better reason than "Contrary to the citations of case law ... it cannot be seen..." I'm sure you'll understand why I found this statement puzzling, and need some explanation of what you meant, and how you believe Federal Circuit law applies to the PTO.

2. Remember that the MPEP has no "force of law," and therefore **never** displaces or weakens any other legal authority.

> The MPEP has not been promulgated with the rule-making formalities of 5 U.S.C. § 553, and thus "does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations." MPEP Foreword; *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988) (MPEP "does not have the force of law, but it 'has been held to describe procedures on which the public can rely.'"). As such, the MPEP can never impose additional burdens on applicants, or attenuate rights of applicants, beyond an interpretation fairly attributable to the text of a rule that <u>does</u> have force of law.
>
> However, the MPEP is a set of instructions to PTO personnel, issued pursuant to the authority of the Director to regulate proceedings of the Office, with the promise and intent that applicants be entitled to rely on the PTO's observance of those instructions. *Ethicon*, 849 F.2d at 1425, 7 USPQ2d at 1154; *In re Kaghan*, 387 F.2d 398, 847-48, 156 USPQ2d 130, 132 (CCPA 1967) ("we feel that an applicant should be entitled to rely not only on the statutes and Rules of Practice but also on the provisions of the MPEP in the prosecution of his patent application"); MPEP Foreword.

3. Please take care to cite your sources accurately. For example, MPEP § 2106 says nothing about how applicants are to read examiners' papers – the contrary citation in the 9/9/05 Decision is either a typo or a misreading. (Further, the MPEP cannot weaken the requirements of 37 C.F.R. §§ 1.104 and 1.113 for "clear" and "complete" examination – if you believe that applicants are required to read an examiner's mind, or anticipate and respond to issues the examiner did not raise, in the context of the procedural issues now pending, please cite some authority.)

4. Decide the issues presented. Several issues raised in the Petition are not responded to in the 9/9/05 Decision. Others are reframed inaccurately. If 37 C.F.R. § 1.113(b) and MPEP § 706.07

state requirements that must be met before final rejection, compliance with MPEP § 706.07(a) does not cure a breach. (You can't cure a parking ticket by arguing that you weren't speeding. Same thing here.)

5. If you believe the law allows complete omissions from earlier papers to be cured by raising new issues and citing new evidence in final actions and advisory actions, please provide a citation to such law. Examiner Ellis is hiding his position until final action or advisory actions, either carelessly, or possibly in an effort to game the system and earn additional counts by forcing RCE's. (If you like, we can go through the record, and I'll show you a half dozen instances.) If 37 C.F.R. §§ 1.104, 1.113, and MPEP § 706.07 require that examination must be timely completed, then new issues raised in advisory actions – on issues where the Office Actions were silent – requires that finality be withdrawn. ... 35 U.S.C. § 3(a)(2)(A) ("fair, impartial and equitable") requires bilateral application [of the rules, including] 37 C.F.R., the MPEP, Supreme Court and Federal Circuit procedural law (*e.g.*, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), examiners are required to articulate specific written findings on each element of a *prima facie* case) should be enforced...

In view of the short time remaining before all extensions are exhausted, please FAX your decision to 212 728 9757, in addition to mailing.

David Boundy
Willkie Farr & Gallagher LLP
787 Seventh Avenue
New York, NY 10019
(212) 728 8757
(212) 728 9757 (FAX)